

Reply to Office Action dated March 2, 2010

REMARKS/ARGUMENTS

Favorable reconsideration and allowance of the present application is respectfully requested. Claims 1-21 are pending in the above application, of which claims 1, 9, 11 and 20 are independent.

The Office Action dated March 2, 2010, has been received and carefully reviewed. In that Office Action, claims 1-8 and 17 were rejected under 35 U.S.C. 102(b) as being anticipated by Rossin, claims 20 and 21 were rejected under 35 U.S.C. 102(a) as being anticipated by EP 1,336,736 (hereinafter, "Ritz"), claims 9, 11 and 14-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rossin in view of JP 58-62495 (hereinafter, "Kurohori"), and claims 10, 12, 13, and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rossin in view of Kurohori and further in view of Rinckel. It is believed that all claims are allowable over the art of record, and reconsideration and allowance of claims 1-21 is respectfully requested in view of the above amendments and following remarks.

SPECIFICATION

By the above amendment, the abstract of the disclosure has been amended to remove legal terms such as "comprising". The specification has been amended to remove references to the claims and to add section headings.

PRIORITY DOCUMENT

Submitted herewith is a verified English language translation of the priority document, DE 10346540, filed October 10, 2003.

CLAIM REJECTIONS UNDER 35 U.S.C. 102(b)

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Rossin. Claim 1 as amended recites a charge intercooler for a motor vehicle that comprises a heat exchanger unit with tubes through which charge air can flow and air boxes which are connected to the tubes and that have a charge air inlet and a charge air outlet. One of the air boxes includes a partition wall dividing it into first and second portions and includes a rotary valve rotatable from a first position blocking airflow through the first portion to a second position allowing air flow through the first portion and the second portion. Rossin does not show a rotary valve as recited in amended claim 1, and claim 1 is submitted to be allowable over Rossin for at least this reason.

The version of claim 11 examined by the examiner recited a shut-off member comprising a rotary slide. That claim was rejected under 35 U.S.C. 103(a) as being unpatentable over Rossin in view of Kurohori. It is respectfully submitted that amended claim 1 is also allowable over Rossin in view of Kurohori. Based on the English language abstract and drawings of Kurohori, this reference appears to teach a structure for reversing the direction of air flow through a heat exchanger. In a first position, air flows into a first set of heat exchanger tubes and exits a second set of heat exchanger tubes; in a second position, air flows into the second set of tubes and exits the first set. At most, Kurohori might suggest reversing the air flow in a heat exchanger like that of Rossin. Nothing about Kurohori suggests that Rossin can or should be modified to include a rotary valve for allowing air to pass through either one portion or two portions of an air box. Claim 1 as amended is submitted to patentably distinguish over Rossin

Reply to Office Action dated March 2, 2010

and Kurohori for this reason as well.

If claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rossin and Kurohori, it is respectfully requested that the examiner satisfy the requirements of MPEP 706.02(j) and explain what modification to Rossin is being proposed and, in addition, explain why one of ordinary skill in the art, seeing Kurohori's air flow direction changing system, would attempt to modify Rossin with this teaching to produce the claimed invention.

Claims 2-8, 10, and 12-19 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

CLAIM REJECTIONS UNDER 35 U.S.C. 102(a)

Claims 20 and 21 were rejected under 35 U.S.C. 102(a) as being anticipated by Ritz on the ground that Ritz published before the invention of the present invention by the applicant. It is respectfully submitted that the present invention was conceived and constructively reduced to practice before the publication date of Ritz and that Ritz does not qualify as prior art under 35 U.S.C. 102(a). A declaration under 35 U.S.C. 1.131 is submitted herewith to establish conception of the present invention before Ritz' publication date and diligence from just before Ritz' publication date until constructive reduction to practice by the filing of the priority application on October 3, 2003.

As shown by the inventor's declaration, the present invention was conceived in WTO member Germany prior to April 30, 2003, when an Invention Notice, Exhibit 1 to the declaration, was signed by the inventor. Exhibit 3 to the declaration comprises email correspondence between the inventor and the patent department of Behr GmbH

Reply to Office Action dated March 2, 2010

& Co., the assignee of the present application. These email messages accompanied drawings related to the invention and are dated August 1, 2003, and August 3, 2003. Exhibit IV, an email message dated August 18, 2003, shows that Behr's patent department instructed a German patent attorney to begin work on the application that became the priority patent application on which the above-captioned U.S. patent application was based. Thus, the present invention was conceived and had been approved for the preparation of a patent application prior to the publication date of Ritz. Exhibit V shows that a draft patent application was provided to the inventor on September 11, 2003, and Exhibit VI shows that the inventor provided his approval on September 15, 2003. The priority application based on the above-described disclosure was filed on October 2, 2003.

It is respectfully submitted that the Declaration and Exhibits establish that the invention of claims 20 and 21 was conceived before the publication date of Ritz and constructively reduced to practice, with diligence, after the publication of Ritz. For these reasons, it is respectfully submitted that Ritz does not qualify as prior art under 35 U.S.C. 102(a), and the withdrawal of the rejection of claims 20 and 21 under 35 U.S.C. 102(a) is respectfully requested.

REJECTIONS UNDER 35 U.S.C. 103(a)

Claims 9, 11 and 14-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rossin in view of Kurohori. Claims 9 and 11 have been rewritten in independent form and will be addressed below. Claims 14-18 depend from claim 1. Claim 1 patentably distinguishes over Rossin and Kurohori for the reasons provided

Reply to Office Action dated March 2, 2010

above. Claims 14-18 are therefore submitted to be allowable over Rossin and Kurohori for at least the same reasons as claim 1.

Claim 9 has been rewritten in independent form, but the scope of the claim has not changed. Claim 9 recites a charge intercooler for a motor vehicle that includes a heat exchanger unit with tubes through which charge air can flow and air boxes which are connected to the tubes that have a charge air inlet and a charge air outlet. Claim 9 further recites that some of the tubes can be closed by a shut-off member that is designed as a pivotable flap with a laterally arranged pivot axis and that the tubes form a row R and have tube ends which are accommodated in a tube plate of one of the air boxes, and that the pivot axis is arranged in the direction of the tube row and next to the tube ends in the region of a tube plate, and that the flap is of approximately rectangular design and, in the closure position, rests on the tube ends. Claim 9 also recites that the flap has at least one cutout for one or more nonclosable tubes. It is respectfully submitted that neither Rossin nor Kurohori shows a flap with at least one cutout for one or more nonclosable tubes. It is therefore not clear how Kurohori would suggest to one of ordinary skill in the art that Rossin's flap should be provided with cutouts as the Office Action appears to be proposing. Moreover, given the structure of Rossin, adding cutouts to Rossin's flap 27 would appear to prevent any of the tubes from being closed, contrary to the claim limitation that "some of the tubes can be closed by a shut-off member. This would also change the principle of operation and/or render Rossin unsatisfactory for its intended purpose, and such changes are never obvious according to MPEP 2143.01. For at least these reasons, claim 9 is submitted to be allowable over Rossin and Kurohori.

Reply to Office Action dated March 2, 2010

If the rejection of claim 9 is maintained, it is respectfully requested that the examiner explain what modification to Rossin is being proposed (in order to comply with the requirements of MPEP 706.02(j)). It is also respectfully requested that the examiner explain how Kurohori suggests in any manner that cutouts should be added to Rossin's flap 27. Finally, it is respectfully requested that the examiner explain how the modification to Rossin that is apparently being proposed would not change Rossin's principle of operation and/or render Rossin unsatisfactory for its intended purpose.

The scope of claim 9 has not been changed by rewriting it in independent form. If a new rejection of claim 9 is raised, it will not have been necessitated by this amendment. It is therefore respectfully requested if a new rejection of claim 9 is raised, it be presented in a further, non-final Office Action (MPEP 706.07(a)).

Claim 11 has also been rewritten in independent form. Claim 11 recites a charge intercooler for a motor vehicle that includes a heat exchanger unit with tubes through which charge air can flow and air boxes which are connected to the tubes and that have a charge air inlet and a charge air outlet. Some of the tubes can be closed by a shut-off member, and a partition is arranged in the air box and divides the air box into two chambers with two flow cross sections. One flow cross section can be closed by the shut-off member, and the shut-off member is designed as a rotary slide. Similar limitations were discussed in connection with amended claim 1. Claim 11 is submitted to be allowable over Rossin and Kurohori for at least the reasons provided above in connection with amended claim 1.

Claims 10, 12, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossin in view of Kurohori and further in view of Rinckel. Claims 10,

Reply to Office Action dated March 2, 2010

12, 13 and 19 depend from claim 1. Rinckel does not address the shortcomings of Rossin and Kurohori discussed above in connection with claim 1. Claims 10, 12, 13 and 19 are therefore submitted to be allowable for at least the same reasons as claim 1.

CONCLUSION

Each issue raised in the Office Action dated March 2, 2010, has been addressed, and it is believed that claims 1-19 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited. If the examiner believes that any additional changes would place the application in better condition for allowance, the examiner is invited to contact the undersigned attorney at the telephone number listed below.

Deposit Account Authorization

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 50-3828 and please credit any excess fees to such deposit account.

Respectfully submitted,



Martin R. Geissler
Registration No. 51011

PO BOX 1364
Fairfax, VA 22038-1364
1.703.621.7140
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